

R E M A R K S

Claims 1-28 are pending in the application. Claims 17-27 have been withdrawn from consideration. Applicant amends claim 1 for further clarification. No new matter has been added.

Claims 1-16 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,855,007 to Jovicic et al. in view of U.S. Patent No. 6,076,069 to Laor. Applicant respectfully traverses the rejections.

The Examiner conceded that Jovicic et al. fail to disclose “a server that records coupon owner information and also changes owner information according to a transferee apparatus,” and relied upon Laor as a combining reference that allegedly suggests these features. Page 4, lines 1-12 of the Office Action.

In particular, the Examiner relied upon the description in Laor of electronic coupons being “used in transactions between two businesses, two government agencies,” etc., as alleged suggestion of a “coupon ... being used [as] electronic money.” Page 4, lines 6-12 of the Office Action citing col. 3, lines 24-30 of Laor.

Laor, as cited and relied upon by the Examiner, only describes, however, a “system for distributing and redeeming electronic coupons.” Col. 3, lines 12-13 of Laor. And the above-cited portion of Laor referred to by the Examiner merely includes description of parties to such coupon redemptions—e.g., businesses, government agencies, or governments, as opposed to a merchant and a consumer.

The Examiner argued that “[t]he aspect of ‘to transfer ...’ is considered intended use and does not carry any patentable weight.” Page 2, lines 4-5 of the Office Action.

To the contrary, Applicant respectfully points out that since Laor fails to disclose or suggest any transfer of coupons, Laor correspondingly fails to disclose or suggest the claimed

features of a coupon issuance/management server maintaining ownership identification information for a coupon and changing such ownership identification information in a transfer of the coupon.

Indeed, Laor only describes,

“Preferably, the electronic coupon enables or modifies an anticipated transaction [*singular*] such as providing a discount in the price of goods or services provided by the issuer or the issuer's agent..” Col. 3, lines 18-21 of Laor.
(Emphasis added)

In other words, the “transactions” between other entities such as businesses, government agencies, etc. described in the Examiner-cited portions of Laor only refer to transactions where one entity issues a coupon and the other redeems it. Correspondingly, Laor describes

“In the next step 216, the Server authenticates the electronic coupon. Depending upon the system, the Server could evaluate the electronic coupon to authenticate or validate the electronic coupon, or alternatively, the Server could transfer the electronic coupon information to an Authentication Server which could authenticate or validate the electronic coupon and authorize the transaction. In the next step 218, the electronic coupon is used to modify or enable the transaction and the transaction is completed.”

Thus, again, Laor, as cited and relied upon by the Examiner, only describes coupon information being transmitted in a redemption transaction, and fails to disclose or suggest a coupon remaining after being redeemed in a transaction by an entity to which the coupon is originally issued. Absent such disclosure and suggestion, Laor—and correspondingly, the proposed combination of Jovicic et al. and Laor—clearly fail to disclose or suggest a coupon issuance/management server issuing an electronic coupon to an information terminal, and maintaining and changing owner identification information in a transfer management

memory according to a transmission of the electronic coupon from the information terminal
to a transferee apparatus.

In other words, even assuming, arguendo, that it would have been obvious to one skilled in the art at the time the claimed invention was made to combine Jovicic et al. and Laor, such a combination would still have failed to disclose or suggest,

"[a]n electronic transaction method using an electronic coupon in an electronic transaction system comprising an electronic shop server opening an electronic shop site on Internet to operate and manage said electronic shop site, a coupon issuance/management server issuing and managing an electronic coupon having pecuniary value information usable in a settlement of an electronic transaction for said electronic shop site, and an information terminal being able to access to said electronic shop to carry out an electronic transaction, said electronic transaction method comprising:

requesting said coupon issuance/management server to issue said electronic coupon from said information terminal;
issuing, by said coupon issuance/management server,
said electronic coupon having said pecuniary value information
and original owner identification information based on
information characteristic of said information terminal to said
information terminal;

recording, by said coupon issuance/management server, said owner identification information of said electronic coupon as coupon management information in a transfer management memory of said coupon issuance/management server and managing said owner identification information by said coupon issuance/management server; and

changing, by said coupon issuance/management server,
said owner identification information in said transfer
management memory according to transmission of said
electronic coupon from said information terminal to a
transferee apparatus," as recited in claim 1. (Emphasis added)

Accordingly, Applicant respectfully submits that claim 1, together with claims 2-16 and 28 dependent therefrom, is patentable over Jovicic et al. and Laor, separately and in combination, for at least the above-stated reasons.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should

consider this application not to be in condition for allowance, the Examiner is respectfully
requested to telephone the undersigned attorney at the number listed below prior to issuing a
further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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